

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference NEOME019A2PC	FOR FURTHER ACTION <small>see Form PCT/ISA/220 as well as, where applicable, item 5 below.</small>	
International application No. PCT/US04/18482	International filing date (<i>day/month/year</i>) 10 June 2004 (10.06.2004)	(Earliest) Priority Date (<i>day/month/year</i>) 10 June 2003 (10.06.2003)
Applicant NEOMEDIX CORPORATION		

This international search report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This international search report consists of a total of 3 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the Report

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ The international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).
- b. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.
2. ☐ **Certain claims were found unsearchable** (See Box No. II)
3. ☐ **Unity of invention is lacking** (See Box No. III)
4. With regard to the **title**,
- ☒ the text is approved as submitted by the applicant.
- ☐ the text has been established by this Authority to read as follows:

5. With regard to the abstract,



the text is approved as submitted by the applicant.



the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regard to the drawings,

- a. the figure of the drawings to be published with the abstract is Figure No. 2



as suggested by the applicant.



as selected by this Authority, because the applicant failed to suggest a figure.



as selected by this Authority, because this figure better characterizes the invention.

- b. ☐ none of the figures is to be published with the abstract.

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Box IV TEXT OF THE ABSTRACT (Continuation of Item 5 of the first sheet)

Methods and devices for cutting or coagulating tissue. The device comprises an elongate member (14) having a distal end, at least one foot member (16) extending from the distal end of the elongate member, said foot member (16) having an upper surface (US) and a lower surface (LS), an electrically and thermally insulating cover formed on at least the lower surface of the foot member and at least one electrode (26,28) on the upper surface of the foot member (16). In operation, the at least one electrode (26,28) is energized so as to cause cutting or coagulation of tissue located above the upper surface of the of the foot member (16) while not causing substantial damage to tissue located below the lower surface of the foot member (16).

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A. CLASSIFICATION OF SUBJECT MATTER IPC(7) : A61B 18/18 US CL : 606/41 According to International Patent Classification (IPC) or to both national classification and IPC		
B. FIELDS SEARCHED Minimum documentation searched (classification system followed by classification symbols) U.S. : 606/41, 45-50 Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)		
C. DOCUMENTS CONSIDERED TO BE RELEVANT		
Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X ---	US 6,283,961 B1 (Underwood et al) 04 September 2001, whole document, Figures 17-31	1,5,6,8-10,15-17,19-25,40
Y		2-4,7,11-14,26-39
X ---	US 6,290,699 B1 (Hall et al) 18 September 2001, whole document	1-3,5-7,15,16,18,19,25-27
Y		2-4,7,26-39
A	US 5,681,282 A (Eggers et al) 28 October 1997, whole document	1-39
<input type="checkbox"/> Further documents are listed in the continuation of Box C. <input type="checkbox"/> See patent family annex.		
* Special categories of cited documents:		
"A"	document defining the general state of the art which is not considered to be of particular relevance	"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
"E"	earlier application or patent published on or after the international filing date	"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
"L"	document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
"O"	document referring to an oral disclosure, use, exhibition or other means	"&" document member of the same patent family
"P"	document published prior to the international filing date but later than the priority date claimed	
Date of the actual completion of the international search 23 November 2004 (23.11.2004)		Date of mailing of the international search report 27 DEC 2004
Name and mailing address of the ISA/US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230		Authorized officer Linda Dvorak Telephone No. (703) 308-0858

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
ROBERT D. BUYAN
STOUT, UXA, BUYAN & MULLINS, LLP.
4 VENTURE, SUITE 300
IRVINE, CA 92618

PCTWRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

Response due 3/27/05
(PCT Rule 43bis.1)
Date of mailing: **27 DEC 2004**
(day/month/year)

Applicant's or agent's file reference

NEOME019A2PC

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/US04/18482

International filing date (day/month/year)

10 June 2004 (10.06.2004)

Priority date (day/month/year)

10 June 2003 (10.06.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): A61B 18/18 and US Cl.: 606/41

Applicant

NEOMEDIX CORPORATION

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement.
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US Mail Stop PCT, Attn: ISA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230	Authorized officer Linda Dvorak Telephone No. (703) 308-0858
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Form PCT/ISA/237 (cover sheet) (January 2004)

1/5/05
[Signature]

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

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Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

WRITTEN OPINION OF THE
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Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>4, 11-14 and 28-39</u>	YES
	Claims <u>1-3, 5-10, 15-27 and 40</u>	NO
Inventive step (IS)	Claims <u>NONE</u>	YES
	Claims <u>1-40</u>	NO
Industrial applicability (IA)	Claims <u>1-40</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Claims 1, 5, 6, 8-10, 15-17, 19-25 and 40 lack novelty under PCT Article 33(2) as being anticipated by Underwood et al (6,283,961).

Claims 1-3, 5-7, 15, 16, 18, 19 and 25-27 lack novelty under PCT Article 33(2) as being anticipated by Hall et al (6,290,699).

Claims 2-4, 7, 11-14 and 26-39 lack an inventive step under PCT Article 33(3) as being obvious over Underwood et al (6,283,961) in view of Hall et al (6,290,699). Underwood et al provide a device having a foot member with a thermally/electrically insulated bottom portion and electrodes on the upper portion. However, Underwood et al fail to disclose a bifurcated foot member, the particular material of the bottom surface and all the procedures set forth in the claims. Hall et al disclose an analogous device which includes a foot member for treating tissue. Hall et al specifically disclose that the device may include a plurality of foot members as well as bifurcated foot members for treating various tissue locations. To have provided the Underwood et al device with multiple foot members or a bifurcated foot member for treating specific tissue regions would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Hall et al. Further, to have provided the Underwood et al with any thermally/electrically insulative material on the bottom surface by any means (e.g. coating) is deemed an obvious design consideration for one of ordinary skill in the art. Finally, to have used the Underwood et al device in any desired procedure which commonly employs electrical cutting/coagulation of tissue would have been an obvious consideration for one of ordinary skill in the art.

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under Article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the *PCT Applicant's Guide*, a publication of WIPO.

In these Notes, "Article," "Rule" and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions, respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended ?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Preliminary Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When ? Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments ?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How ? Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments ?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.